

*b6*

a Figure number memory for receiving and storing the highest Figure number used to identify Figures of the drawings;

a reference number processor responsive to said Figure number memory for storing the element names of the elements in the order recited in said duplicate set of claims and for searching and replacing each occurrence of each respective element name in the order of occurrence in said duplicate set of claims with said respective element name followed by successive ones of said even numbers beginning with the first number ending in zero following the highest Figure number to provide identifying reference numerals for said element names in the order of occurrence in said duplicate set of claims;

an abstract processor for selecting and storing abstract sentences including said reference numerals from under said heading DESCRIPTION OF THE PREFERRED EMBODIMENT and duplicating said abstract sentences under said heading ABSTRACT OF THE DISCLOSURE; and

a parenthesis processor for automatically enclosing each reference numeral within parentheses in said claims and in said ABSTRACT OF THE DISCLOSURE.

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**REMARKS**

Claims 1-20 remain in the application with claims 1, 19 and 20 being independent.

The rejection under 35 USC Section 112 regarding the reference numerals in the claims has been overcome by deleting all such reference numerals in the claims.

The reference to claim 9 and the recitation of taking sentences from the description for the abstract is a limitation, a very important limitation. In many instances the abstract is of the "invention" and duplicates a claim whereas the abstract is to be of the disclosure and suitable for a technical person to read and appreciate what is disclosed in the application in contradistinction to that which is claimed. Claim 9 is not indefinite, it merely recites an important limitation.

The '833 patent to Newman analyses an existing patent it does not create one as claimed herein. As stated beginning at line 43 of column 2 of Newman, "the analysis process begins with a specified patent application or issued patent . . ." Claim 1 distinguishes over the prior art by the step of "storing a duplicate set of all of the claims in the computer program, and retrieving the duplicate set of claims under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT." This is a very important first step in that the program duplicates the claims exactly in the description. Thereafter, as recited in further dependent claims, the duplicates are edited into proper grammatical form to thereby provide exact antecedent basis for the claims in the description. The headings set forth in claim 1 will be varied depending upon the current requirements of the USPTO but Claim 1 is very specific to the novelty of duplicating the claims under that portion of the application where the detailed description of the implementation of the invention occurs in the specification. None of the prior art references suggest such a step of exactly duplicating the claims in the description for editing.

Editing is well known in numerous environments as suggested by the Examiner. However, claim 2 specifically recites the step of replacing the specific

word "said" with the word --the--. Such a specific step is not suggested by the references. Just because the MPEP limits the use of legal phraseology does not suggest the steps of searching for "said" and automatically replacing same with the word "the" as recited in claim 2.

Just because it is well known to place proper antecedent basis for the claims in the description does not suggest the limitations of claim 3 of copying claim 1 into the **SUMMARY OF THE INVENTION** for editing.

Regarding claims 4-7, nowhere is there a suggestion of the specific steps set forth therein of applying a reference numeral to all occurrences of an element in response to first applying the first numeral to that element. This is a step in creating the document not checking for errors as in Newman '833.

The same deficiency exists in regard to the rejection of claims 8-18 wherein Newman '833 is deficient because it relates to checking and not creating. There is no teaching in Newman '833, which leads one to the invention claimed herein.

Claims 19 and 20 are independent claims that specifically define all of the novelty of the invention and are not remotely suggested by the prior art. No where does the prior art suggest the following combination :

- (1) retrieving the stored independent claim under the heading **SUMMARY OF THE INVENTION AND ADVANTAGES**, and editing the duplicate independent claim into grammatically correct sentence structure including changing the word "said" to --the-- and adding verbs whereby the **SUMMARY OF THE INVENTION AND ADVANTAGES** is commensurate in scope to the independent claim;

(2) retrieving the duplicate set of claims into the specification under the heading relating to the detailed description;

(3) searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word --the-- in the duplicate set of claims copied into the specification, and editing the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs;

(4) storing the element names in the computer program of the elements in the order recited in the duplicate set of claims, storing in the computer program successive even numbers beginning with a number above the highest Figure number to identify the respective element names, and searching in the computer program for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims in the description and replacing each respective element name with that respective element name followed by successive ones of the even numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims in the description; and

(5) selecting and storing in the computer program abstract sentences including reference numbers from under the description heading which most succinctly and specifically describe the elements shown in the drawings with a description of the elements in the characterized by clause commensurate with the specificity recited in dependent claims.

The law is adequately set forth in the MPEP:

**2143.03            All Claim Limitations Must Be  
Taught or Suggested [R-1]**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**2142            Legal Concept of *Prima Facie*  
Obviousness [R-1]**

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness ...

**ESTABLISHING A *PRIMA FACIE* CASE OF  
OBVIOUSNESS**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must

present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

None of the references suggest creating a patent application let alone such a combination of creation steps. The references do not meet the standards of prima facie obviousness set forth above in the MPEP.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Applicant by this Response does not intend to abandon any equivalents under the doctrine of equivalents for the scope of any claim element between the literal scope of the claim element and the scope of the prior art. Any element added to any claim is deemed to claim in a new application. Any amendment made to any claim is made subject to an equivalency existing between the language added and the prior art that need not be detailed here. Furthermore, any changes to the claims have been solely for the purpose of clarifying the invention as set forth in each of those claims.

Attached to the end of this document is a marked up version of the amendments to the specification and claims entitled VERSION WITH MARKINGS TO SHOW CHANGES MADE

The Commissioner is authorized to charge our Deposit Account No. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

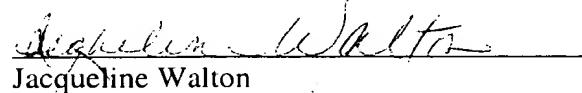


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Date: May 21, 2002  
HWM/alk

**CERTIFICATE OF MAILING**

I hereby certify that the attached Amendment for application serial number 09/273,021 filed March 19, 1999 is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner of Patents, Washington, D.C. 20231, on this May 21, 2002.



Jacqueline Walton

**VERSION WITH MARKS TO SHOW CHANGES MADE**

**IN THE ABSTRACT:**

Please amend the paragraph staring on line 4 of the Abstract page as follows:

A computer program and a computer [fir] for drafting a patent application including a template memory for storing and duplication standard headings and paragraphs of a patent and which interacts with other memories and processors to provide a structure and process to follow in preparing a patent application. An independent claim processor (12) duplicates an independent claims under the heading SUMMARY OF THE INVENTION AND ADVANTAGES and edits same into a grammatically correct sentence structure. A multiple claim processor (14) duplicates all of the claims under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT and edits same into grammatically correct sentence structure. Also included are a reference number memory (16), which stores successive even numerals beginning with the number ten, and a Figure number memory (18), which stores the highest Figure number used to identify Figures of the drawings. A reference number processor (20) is responsive to the Figure number memory (18) for searching and adding an reference numerals to the element names in the order of occurrence. An abstract processor (22) is included for selecting and storing and duplicating abstract sentences into the abstract from the description. A parenthesis processor (24) is included for automatically enclosing each reference numeral within parentheses in claims and in the abstract.

**IN THE CLAIMS:**

1. (Amended) A method of preparing a patent application with a computer comprising the steps of:

storing [~~10~~] a document template in a computer program which contains the headings:

#### **BACKGROUND OF THE INVENTION**

1) Field of the Invention

2) Description of the Prior Art

#### **SUMMARY OF THE INVENTION AND ADVANTAGES**

#### **BRIEF DESCRIPTION OF THE DRAWINGS**

#### **DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT**

#### **CLAIMS**

#### **ABSTRACT OF THE DISCLOSURE;**

storing a page break before the CLAIMS heading in the computer program;

storing a page break before the ABSTRACT OF THE DISCLOSURE heading in the computer program;

storing a footer in the computer program for displaying the attorney file identification on every page of the application;

drafting an independent claim ending in a clause beginning with the words "characterized by" and reciting and isolating the patentable novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the characterized by clause;

drafting claims ultimately dependent upon the independent claim for successively more specifically defining the patentable novelty; and

characterized by storing [(14)] a duplicate set of all of the claims in the computer program, and retrieving the duplicate set of claims under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT.

Please amend claim 3 as follows:

3. Amended The method as set forth in claim 2 including the steps of storing [(12)] a duplicate of the independent claim in the computer program, retrieving the duplicate independent claim under the heading SUMMARY OF THE INVENTION AND ADVANTAGES, and editing the duplicate independent claim copied under the heading SUMMARY OF THE INVENTION AND ADVANTAGES

into grammatically correct sentence structure including changing "said" to --the-- and adding verbs without adding further description whereby the SUMMARY OF THE INVENTION AND ADVANTAGES is commensurate in scope to the independent claim.

Please amend claim 4 as follows:

4. (Amended) The method as set forth in claim 3 including the steps [~~16, 18, 20~~] of storing the element name of the first element recited in the duplicate set of claims and shown in the drawings, storing the first element name followed by a first selected even number above the highest numeral used to identify a Figure in the drawings, searching for each occurrence of the first element name and replacing same with the first element name followed by the selected even number to provide a first identifying reference numeral for the first element name.

Please amend claim 5 as follows:

5. (Amended) The method as set forth in claim 4 including the steps [~~16, 18, 20~~] of storing the element name of the second element recited in the duplicate set of claims and shown in the drawings, storing the second element name followed by the next even number following the reference numeral used to identify the first element name, searching for each occurrence of the second element name and replacing same with the second element name followed by said next even number to provide a second identifying reference numeral for the second element name.

Please amend claim 7 as follows:

7. (Amended) The method as set forth in claim 3 including the steps [16, 18, 20] of storing the element names of the elements in the order recited in the duplicate set of claims, storing successive even numbers beginning with a number above the highest Figure number to identify the respective element names, and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims and replacing each respective element name with that respective element name followed by successive ones of said even numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims.

Please amend claim 9 as follow:

9. (Amended) The method as set forth in claim 7 including the steps [22] of selecting and storing abstract sentences including reference numbers from under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT which most succinctly and specifically describe the elements shown in the drawings with a description of the elements in the characterized by clause commensurate with the specificity recited in dependent claims, and retrieving the abstract sentences under the heading ABSTRACT OF THE DISCLOSURE.

Please amend claim 10 as follows:

10. (Amended) The method as set forth in claim 9 including the step [24] of storing each reference numeral recited in the CLAIMS and in the ABSTRACT OF THE DISCLOSURE within parenthesis ( ), searching and replacing each such reference number in the CLAIMS and in the ABSTRACT OF THE DISCLOSURE with the corresponding stored reference number within parentheses ( ).

Please amend claim 19 as follows:

19. (Amended) A method of preparing a patent application with a computer characterized by performing the following steps:

storing [10] a document template in a computer program which contains the headings,

#### BACKGROUND OF THE INVENTION

1)Field of the Invention

2)Description of the Prior Art

#### SUMMARY OF THE INVENTION AND ADVANTAGES

#### BRIEF DESCRIPTION OF THE DRAWINGS

#### DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

#### CLAIMS

#### ABSTRACT OF THE DISCLOSURE;

storing a page break in the computer program before the CLAIMS heading;

storing a page break in the computer program before the heading  
**ABSTRACT OF THE DISCLOSURE;**

storing a footer in the computer program for displaying the attorney  
file identification on every page of the application;

storing a Figure paragraph in the computer program immediately after  
the heading **BRIEF DESCRIPTSON OF THE DRAWINGS;**

storing a terminal paragraph in the computer program stating it is to be  
understood that reference numerals in the claims are merely for convenience and are  
not to be in any way limiting immediately before the page break before the heading  
**CLAIMS;**

drafting an independent claim beginning with the words characterized  
by and ending in a clause reciting and isolating the patentable novelty and preceded  
by at least one clause reciting prior art elements only to the extent necessary to  
support and provide antecedent basis for the recitations in the characterized by clause;

drafting claims ultimately dependent upon the independent claim for  
successively more specifically defining the patentable novelty;

storing **[42]** a duplicate of the independent claim in the computer  
program,

retrieving the stored independent claim under the heading **SUMMARY  
OF THE INVENTION AND ADVANTAGES**, and editing the duplicate independent  
claim copied under the heading **SUMMARY OF THE INVENTION AND  
ADVANTAGES** into grammatically correct sentence structure including changing  
the word "said" to --the-- and adding verbs without adding further description

whereby the SUMMARY OF THE INVENTION AND ADVANTAGES is commensurate in scope to the independent claim;

storing [(14)] a duplicate set of all of the claims in the computer program, and retrieving the duplicate set of claims under the heading DESCRIPTION OF THE PREFERRED EMBODIMENT;

searching for each occurrence of the word "said" in the duplicate set of claims copied into the specification, programming the computer program to replace the word "said" with the word --the-- in the duplicate set of claims copied into the specification, and editing the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs;

storing the element names in the computer program of the elements in the order recited in the duplicate set of claims, storing [(16)] in the computer program successive even numbers beginning with a number above the highest Figure number [(18)] to identify the respective element names, and searching [(20)] in the computer program for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims and replacing each respective element name with that respective element name followed by successive ones of the even numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims;

adding each reference numeral to every showing of the element in the drawings in response to that element being assigned a reference numeral;

selecting and storing [(22)] in the computer program abstract sentences including reference numbers from under the heading DESCRIPTION OF

THE PREFERRED EMBODIMENT which most succinctly and specifically describe the elements shown in the drawings with a description of the elements in the characterized by clause commensurate with the specificity recited in dependent claims, and retrieving the abstract sentences under the heading ABSTRACT OF THE DISCLOSURE;

storing [24] in the computer program each reference numeral recited in the CLAIMS and in the ABSTRACT OF THE DISCLOSURE within parenthesis ( ), searching in the computer program and replacing each such reference numeral in the CLAIMS and in the ABSTRACT OF THE DISCLOSURE with the corresponding stored reference number within parentheses ( ).

20. (Amended) A computer program and a computer comprising:  
a template memory [10] containing a document template containing  
the headings,

#### BACKGROUND OF THE INVENTION

1) Field of the Invention

2) Description of the Prior Art

#### SUMMARY OF THE INVENTION AND ADVANTAGES

#### BRIEF DESCRIPTION OF THE DRAWINGS

#### DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

#### CLAIMS

ABSTRACT OF THE DISCLOSURE; and

a page break before said heading CLAIMS in the computer program;  
and

a page break separating said heading ABSTRACT OF THE  
DISCLOSURE from the remainder of said headings in the computer program; and

a footer for displaying the attorney file identification in the margin of  
every page of the application; and

the paragraph

Other advantages of the present invention will be readily appreciated  
as the same becomes better understood by reference to the following detailed  
description when considered in connection with the accompanying drawings  
wherein:

Figure 1 is ;

Figure 2 is ;

Figure 3 is ;

Figure 4 is ; and

Figure 5 is .

immediately after the heading BRIEF DESCRIPTION OF THE DRAWINGS; the  
following paragraphs

The invention has been described in an illustrative manner,  
and it is to be understood that the terminology which has been

used is intended to be in the nature of words of description rather than of limitation.

Obviously, many modifications and variations of the present invention are possible in light of the above teachings. It is, therefore, to be understood that within the scope of the appended claims, wherein reference numerals are merely for convenience and are not to be in any way limiting, the invention may be practiced otherwise than as specifically described.

immediately before said page break preceding the heading CLAIMS;

and characterized by an independent claim processor [12] for duplicating and storing an independent claim under the heading SUMMARY OF THE INVENTION AND ADVANTAGES and for editing the duplicated independent claim copied under the heading SUMMARY OF THE INVENTION AND ADVANTAGES into grammatically correct sentence structure including changing "said" to --the-- and adding verbs whereby the SUMMARY OF THE INVENTION AND ADVANTAGES is commensurate in scope to said independent claim;

a multiple claim processor [14] for duplicating and storing all of the claims under said heading DESCRIPTION OF THE PREFERRED EMBODIMENT and for searching and replacing each occurrence of the word "said" in said duplicate set of claims copied under the heading DESCRIPTION OF THE PREFERRED

EMBODIMENT with the word --the--, and for editing said duplicate set of claims into grammatically correct sentence structure;

a reference number memory [(16)] for storing successive even numbers beginning with the number ten;

a Figure number memory [(18)] for receiving and storing the highest Figure number used to identify Figures of the drawings;

a reference number processor [(20)] responsive to said Figure number memory [(18)] for storing the element names of the elements in the order recited in said duplicate set of claims and for searching and replacing each occurrence of each respective element name in the order of occurrence in said duplicate set of claims with said respective element name followed by successive ones of said even numbers beginning with the first number ending in zero following the highest Figure number to provide identifying reference numerals for said element names in the order of occurrence in said duplicate set of claims;

an abstract processor [(22)] for selecting and storing abstract sentences including said reference numerals from under said heading DESCRIPTION OF THE PREFERRED EMBODIMENT and duplicating said abstract sentences under said heading ABSTRACT OF THE DISCLOSURE; and

a parenthesis processor [(24)] for automatically enclosing each reference numeral within parentheses in said claims and in said ABSTRACT OF THE DISCLOSURE.